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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,772	03/15/2002	Gary L. Long	END-838	4856

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EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,772

Applicant(s)

LONG ET AL.

Examiner

Peter J Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 5-8, 20-21, 24-27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsui ('157).

Independent claims 1,20,29

Mitsui discloses a method of treating tissue within a patient comprising:

providing an endoscope (figure 1) with at least one channel (22) for accessing the treatment site and an attached guiding mechanism (figure 3; combo of 27,19,23);

providing at least one flexible instrument (21) having a distal end (10);

extending at least a portion of the instrument from a distal end of the endoscopic channel to access the treatment site; and

guiding motion (see figures 2,3, and 5) of the distal end of the instrument at the treatment site.

Dependent claims

Re: claims 2,3,5,6,21,24,25, and 28, Mitsui discloses a device (27) that restricts twisting, provides bending, and constrains motion about an arced (figure 3) predetermined path (29).

Re: claim 7, Mitsui inherently discloses a channel having a proximal opening outside the patient and a distal opening inside the patient.

Re: claims 8, 26, 27, Mitsui discloses positioning the distal end of the instrument adjacent a lumen wall ("body cavity"; col. 1:7-8). It's inherent from the depiction in figure 2 that the instrument (21) would be used to treat tissue located adjacent the perimeter of the distal end (10) of the endoscope because the instrument reaches beyond the cross-sectional diameter of the endoscope.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-11, 13-17, 20-21, and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsui et al. ('503).

Independent claims 1,14,20,29

Matsui discloses a method of treating tissue within a patient comprising:

providing an endoscope (figure 48) with two channels (191,192) for accessing the treatment site and an attached guiding mechanism (201);

providing at two flexible instruments (205,206);
extending at least a portion of the instrument from a distal end of the endoscopic channel to access the treatment site; and
cooperating motion (see figures 49 and 50) of the distal ends of the instruments at the treatment site.

Dependent claims

Re: claims 2,3,5,6,21,24,25, and 28, Matsui discloses a device (201) that restricts twisting, provides bending, and constrains motion about an arced (figure 48) predetermined path.

Re: claim 7, Matsui inherently discloses a channel having a proximal opening outside the patient and a distal opening inside the patient (figure 44).

Re: claims 8, 26, 27, Matsui discloses positioning the distal end of the instrument adjacent a lumen wall (figure 44). It's inherent from the depiction in figure 45 that the instrument (21) would be used to treat tissue located adjacent the perimeter of the distal end (10) of the endoscope because the instrument (186 in figure 45) reaches beyond the cross-sectional diameter of the endoscope.

Re: claims 9,10,11, and 13, Matsui discloses ablative (through the use of high frequency current) tissue cutting and suction removal col. 18:62 through col. 19:5.

Re: claim 15, Matsui depicts cooperating motion comprising engaging the distal ends of the first and second instruments, one with the other in figures 49 and 50.

Re: claims 16 and 17, see explanations above for claims 2,3,5,6,21,24,25, and 28, in combination with explanations for claim 15.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4,18,19, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui or Matsui.

Optimal bending angles would have been determined through routine experimentation.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui in view of Farin et al. ('026).

Farin et al. discloses a hollow tubular member for use in an endoscope (see figure 6) such as that in Mitsui in communication with a source of argon plasma (patented claim 1; col. 1:10) and an electrode (22).

The motivation to combine Farin and Mitsui would be to provide operational control (through the Mitsui controlling mechanism) to an additional type of end effector (argon plasma, electrode).

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui in view of Wilk et al. ('433).

Wilk discloses in an analogous suturing device two medical instruments (48 and 58) in figure 6e. It would have been obvious in light of this disclosure that the Wilk dual instrument configuration could be used in Mitsui and that the controlling mechanism in Mitsui could have been used to provide better operator controlled interaction/association between the two instruments. Herein lies the motivation for the combination.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ouchi ('087), element 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Vrettakos whose telephone number is 703 605 0215. The examiner can normally be reached on M-F 9-6.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on 703 308 0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0858.

Pete Vrettakos
September 17, 2003



ROY D. GIBSON
PRIMARY EXAMINER